BLO/0622/25

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK NO 3806343
IN THE NAME OF VINOS CRÍA CUERVOS, S.L. FOR

¡OJO!
CRÍA
CUERVOS

IN CLASS 33

AND CANCELLATION APPLICATION THERETO UNDER NO 505785
BY TEQUILA CUERVO, S.S. DE C.V.

BACKGROUND AND PLEADINGS

1. On 5 July 2022, Vinos Cría Cuervos S.L. ("VCC") applied to register the trade mark shown on the cover page of this decision in class 33 for 'Wine'. It was subsequently registered on 14 October 2022.

2. Tequila Cuervo, S.A de C.V. ("TC") seeks invalidation of the registration under the provisions of sections 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under sections 5(2)(b) and 5(3) of the Act and relies on the following trade marks:

Mark details:	**Goods relied on:**
907487192 **CUERVO** **Filed:** 22 December 2008 **Registered:** 23 July 2009	**Class 33** Alcoholic beverages; alcoholic cocktails; tequila.
917498551 **CUERVO** **Filed:** 20 November 2017 **Registered:** 16 April 2018	**Class 33** Alcoholic cocktails; tequila; Alcoholic beverages [except beers].

906711 **CUERVO** **Filed:** 14 March 1967 **Registered:** 14 March 1967 **Mark description:** The mark consists of a Spanish word meaning 'Raven'.	**Class 33** Spirits (beverages).
900811919 **JOSE CUERVO** **Filed:** 27 April 1998 **Registered:** 7 June 1999	**Class 33** Alcoholic beverages, including tequila.

TC's case under the section 5(2)(b) ground

3. Section 5(2)(b) of the Act prevents registration of a mark that is similar to TC's earlier marks, for goods and/or services that are the same or similar to those of TC, such that there will be a likelihood of confusion.

4. In its statement of grounds TC submits:

“4…there are clear visual, phonetic and conceptual similarities between the respective marks. Therefore, the mark applied for is to be considered as highly similar to the Cancellation Applicant's earlier marks.

5…the goods covered by the Cancellation Applicant's earlier marks in Class 33, are identical or at least highly similar to the goods covered by the Contested Registration in Class 33.

7. In view of the high degree of similarity between the mark and the identical and/or highly similar goods, the Cancellation Applicant concludes that there is a likelihood of confusion between the trade marks in question. Therefore, the relevant public are likely to believe that the goods in question come from the same undertaking or from economically linked undertakings.”

TC’s case under the section 5(3) ground

5. The 5(3) ground of opposition requires TC to show its earlier marks have a reputation in the UK such that the registration of the contested mark(s), without due cause, would allow them to take unfair advantage of, or be detrimental to, the distinctive character or the repute of TC’s earlier trade marks.

6. TC submits that its earlier marks have a reputation in the UK such that the use of the proprietor’s mark, without due cause, will take unfair advantage of and/or be detrimental to the distinctive character and repute of TC's earlier trade marks.

7. With regard to damage, TC claims that VCC will gain an unfair advantage because:

“10. Consumers are likely to associate the Ojo! CRIA CUERVOS Logo with the Cancellation Applicant's well-established reputation for its CUERVO and JOSE CUERVO marks and thus the Applicant would enjoy an advantage in the marketplace and derive an illegitimate benefit from it, which is unfair.”

8. It also relies on detriment to the repute of its earlier marks, it says:

> *11…any connection made by consumers between the Cancellation Applicant's established brand and the Proprietor's goods is likely to cause detriment to the reputation of the Cancellation Applicant's trade marks, particularly if the Proprietor's goods are of lower quality than the Cancellation Applicant's products. As there is in fact no economic relationship between the Proprietor and the Cancellation Applicant, the Cancellation Applicant does not have any ability to exercise quality control over the Proprietor's goods which could result in detriment to the Cancellation Applicant's marks.*
>
> *12. Further, there is a risk of detriment to the distinctive character of the Cancellation Applicant's marks as a result of an association with the Proprietor's mark. This has the potential to reduce the value of the trade marks and also to affect the purchasing decisions of consumers in the marketplace."*

9. In its initial pleadings TC claimed a reputation for all of the goods listed in class 33 for each of its earlier marks. In its skeleton argument this was reduced to a reputation for 'tequila' and 'cocktails'.

10. VCC filed a counterstatement in which it denied all the grounds of opposition.

11. TC filed evidence and a skeleton argument. A hearing took place before me at which TC was represented by Tom St Quentin of Counsel, instructed by Potter Clarkson LLP. VCC did not attend the hearing but filed submissions in lieu.

12. I make this decision having taken full account of all the papers before me and the submissions made at the hearing.

13. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

TC's best case

14. In its skeleton argument and at the hearing Mr St Quentin identified, as TC's best case under the 5(2)(b) ground, its earlier '551 registration for CUERVO in class 33. This is because it is closer to the contested mark than the JOSE CUERVO mark, has the widest specification and is not subject to proof of use requirements.[1]

15. TC's skeleton argument was filed with the tribunal before VCC filed its written submissions. Those submissions raised, for the first time, two points relating to the '551 mark, namely evergreening and bad faith.

Evergreening

(namely, re-filing for the same trade mark to avoid the 5 year proof of use period)

16. VCC draws my attention to the specification of '551', which is identical to the '192 CUERVO mark that is subject to proof of use.[2] At paragraph 11 it submits:

> *"11. It seems that the filing of the junior registration might have been made with the intention to circumvent the five years non-use rule, and is evergreening. Whilst the validity of the junior mark is not challenged in the context of these proceedings, it should be considered whether it would be necessary for the trade mark owner to prove use of the mark in spite of it not being registered for over 5 years."*

17. It relies on two European Union Intellectual Property Office (EUIPO) decisions in support of this point. The first is PATHFINDER,[3] which found that proof of use extends to a mark relied upon in the opposition that itself is not yet subject to use requirements where there is an earlier registration for the same mark covering identical goods and services. The second is KABELPLUS,[4] which found that several earlier marks of the opponent had to be considered re-filings and that proof of use must be presented.

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[1] See section 6A of the Act.

[2] There is a small difference in the specifications that reflects an administrative change to the Nice Classification system that added [except beers] to the term alcoholic beverages in class 33.

[3] See case R 1785/2008–4.

[4] Referred to by VCC as CANAL PLUS, which was the earlier right and not the contested mark. See case R 1260/2013–2.

Bad faith

18. VCC also relies on MONOPOLY,[5] which was a bad faith case based on evergreening, in which the General Court (GC) found that applying for the same mark again to avoid the five year proof of use requirement was a basis for bad faith because:

> "... the filing strategy...calls to mind a case of an abuse of law, which is characterised by the fact that, first, despite formal observance of the conditions laid down by the EU rules, the purpose of those rules has not been achieved, and that, secondly, there is an intention to obtain an advantage from those rules by creating artificially the conditions laid down for obtaining it ...".

19. Mr St Quentin dealt with these points by filing additional authorities and by addressing me on both points at the hearing. In brief they are:

- Neither evergreening nor bad faith were mentioned in VCC's TM8 or counterstatement
- VCC's TM8 did not request proof of use be shown for the '551 mark
- The approach taken by the EUIPO in PATHFINDER and KABELPLUS has been rejected by the GC in Aldi v EUIPO (SKYLITE)[6] and KID-Systeme GmbH v EUIPO (SkyFi).[7]
- These points were not foreshadowed in any of the documents filed by VCC and as a result TC was 'taken by surprise'.

20. The two cases before the EUIPO that VCC relies on are not binding on me and even if they were, the points that are the basis of TC's argument have already been rejected by a higher court in the same jurisdiction.

21. Furthermore, submissions filed two days before a hearing are not the place to bring in new grounds under section 3(6) alleging bad faith on the part of TC. TC's reliance on

[5] See T–633/19.
[6] See case T–736/15 at [17]–[41].
[7] T–354/18 ETMR 42 at [37]–[49].

its ‘551 mark was obvious from the beginning of these proceedings and VCC elected not to request proof of use of that mark in its TM8 or to challenge it in these proceedings by requesting to add additional grounds. In addition, VCC could have initiated invalidation proceedings against the ‘551 mark in separate proceedings.

22. For all of the reasons given, I reject these points made by VCC and will give them no further consideration.

DECISION

23. I will begin by assessing TC's self-described, best case, under the 5(2)(b) ground, based on its ‘551 mark.

5(2)(b) of the Act reads:

> “5. - (2) A trade mark shall not be registered if because -
>
> (a)…
>
> (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

24. I bear in mind the following principles gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Markets (OHIM)*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;

(d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) However, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) A lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) There is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) Mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) The reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) If the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Goods comparison

25. TC relies on its goods in class 33, which include 'alcoholic beverages [except beers]'. VCC's mark is registered for 'wine' in class 33.

26. In *Gérard Meric v OHIM*,[8] (Meric) the GC stated:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

27. In accordance with guidance in *Meric*, wine is included within the broad term alcoholic beverages and the competing goods are therefore identical.

Average consumer

28. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

[8] Case T- 133/05.

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".

29. VCC submits the average consumer is the adult public at large. I agree. The parties' goods range from reasonably low prices to very high prices and that is true of wines and alcoholic beverages at large. Purchasers of such beverages are likely to consider factors such as, inter alia, origin, ingredients, flavour, grape type (particularly for wines), vintage and strength, which would result in at least a medium degree of attention being paid to the purchase.

30. The purchase is likely to be a primarily visual one, being made from a website or from a physical retailer, bar or restaurant. However, I do not rule out an aural element where word of mouth recommendation plays a part, though this would be unlikely to occur in isolation and the purchaser would still likely look at the bottle and label prior to or during the serving or purchase of the wines and other alcoholic drinks.

Comparison of marks

31. The competing marks are as follows:

TC's mark	VCC's mark
CUERVO	¡OJO! CRÍA CUERVOS

32. TC's mark is a plain word mark in block capitals. It is likely to be seen as an invented word or a word from another language, not readily understood by the average consumer. The overall impression of the earlier mark rests in the whole mark.

33. VCC's mark is presented in a slightly stylised typeface. The smaller ¡OJO! element with exclamation marks either side is much smaller than the CRÍA and CUERVOS parts of the mark. This, along with the inverted exclamation mark at the start of ¡OJO!, with which the average UK consumer is not familiar, gives that element of the contested mark a decorative significance. Consequently, it plays a lesser role in the overall impression of the mark as a whole. The CRIA and CUERVOS elements are presented in the same size, one above the other. They are significantly larger than the ¡OJO! element. The words themselves will be seen as words from another language or as invented words and are unlikely to be understood by the average consumer. However, it is the two larger words that dominate the overall impression of the mark.

Visual similarity

34. TC submits that there is clearly similarity between the contested registration and the earlier mark because they are partially identical, in that they both include the word 'CUERVO'. It accepts that the CRÍA element provides some difference, but concludes that the common 'CUERVO' element provides significant overall similarity.

35. VCC submits that the marks are visually dissimilar. It says:

> *"The addition[al] elements iOJO! CRIA, which appear at the beginning of the Registration add sufficient visual differences to the respective signs. It should be noted at this point that, as a general rule of thumb, the average consumer will generally pay higher attention to the first element of the mark, which is the terms iOJO! and CRIA. It is correct that the term iOJO! is of a smaller size than the remaining elements, but that is not the case with CRIA, which is of the same size as CUERVOS.*

We deny that there is any degree of visual similarity. The stylization of the Registration is also another point of visual difference.”

36. I disagree with VCC that there is no visual similarity. As TC correctly submits, both marks contain ‘CUERVO’, which is the whole of the earlier mark and is the first six of seven letters in the second word ‘CUERVOS’ in the contested mark. The marks differ in the additional elements contained in the contested mark, namely, the ‘S’ added to CUERVO, the word CRÍA before CUERVOS and the, much smaller, ¡OJO! element at the beginning of the mark. Taking into account my earlier findings concerning the overall impression given to the average consumer by the marks, overall, I find the marks are visually similar to a low to medium degree.

Aural similarity

37. TC submits that as the marks both contain CUERVO, there is a degree of aural similarity between them.

38. VCC submits that there are clear differences in the way the marks are pronounced:

“…the Registration features three verbal elements iOJO! CRIA CUERVOS, whilst the earlier marks feature just the term CUERVO… The differences in the pronunciation of the respective marks are quite striking, especially given that the only word in common is pronounced at the end and it would be diluted within the pronunciation of the Registration. Accordingly, any level of similarity from an aural point of view is very low.”

39. For the reasons provided above, I do not find it likely that the average consumer would articulate the iOJO! element of the contested mark. The articulated elements will more likely be CUERVO and CRÍA CUERVOS. CRÍA will likely be pronounced CREE-AH. The first five letters of CUERVO and CUERVOS will be pronounced the same way in each case. The ends of the words will be pronounced ‘OH’ and ‘OSS’, respectively. I find these marks aurally similar to a slightly less than medium degree. If the ¡OJO! element is pronounced then the similarity would be lower still. However, given my

assessment of the relative weight this element plays in the overall impression of the contested registration, it is more likely that the ¡OJO! element will not be pronounced.

Conceptual similarity

40. TC submits that conceptually, if one ignores the effect of the use of the earlier marks, both evoke the Spanish language and there is no distinction between them conceptually.[9]

41. VCC submits that its mark, iOJO! CRiA CUERVOS, is an evocation of a well-known saying in Spanish ‘CRIA CUERVOS Y TE SACARAN LOS OJOS’, which means ‘raise crows, and they'll gouge out your eyes’.

42. VCC accepts that the saying may not be understood by a significant proportion of the relevant public in the UK but submits that for the part of the public that understands Spanish the conceptual meaning of the respective marks would be very different. CUERVO on its own, would be understood to mean ‘raven’. It concludes that for those who do not speak Spanish the respective marks being compared here will not have a meaning.

43. I agree. The average UK consumer cannot be considered to understand the Spanish language sufficiently to know that the contested mark is an evocation of a Spanish saying. Neither mark gives the average consumer a conceptual message.

Distinctive character of the earlier mark

44. In Lloyd Schuhfabrik Meyer, the Court of Justice of the European Union (CJEU) stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of

[9] See 28.3 of TC’s written submissions.

> other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Alternberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

45. Registered trade marks possess varying degrees of inherent distinctive character. Marks that are suggestive of, or allude to, a characteristic of the goods or services would sit at the lower end of a spectrum of distinctiveness, while those marks that are invented words with no allusive qualities would sit towards the top. TCs earlier mark CUERVO has no meaning for the average UK consumer and is, prima facie, highly distinctive for its goods in class 33.

46. I note that TC has filed evidence of use but by its own submission, its use of the CUERVO marks is made in respect of a narrower range of goods in class 33 than 'alcoholic beverages [except beer]' for which this mark is covered. I have already found CUERVO to be inherently, highly distinctive for the full range of goods in the '551 specification, so it is plain that a detailed assessment of evidence of use of the CUERVO mark for a smaller category of goods cannot result in elevating the distinctive character of the earlier CUERVO mark beyond its already high level of inherent distinctiveness.

Likelihood of confusion

47. There is no scientific formula to apply in determining whether there is a likelihood of confusion. It is a global assessment where a number of factors need to be borne in mind.

I must also take account of the interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or services or vice versa. I keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have in their mind.

48. In this case, the earlier mark is highly distinctive for alcoholic beverages and the competing goods are identical. The average consumer is an adult member of the general public and the marks are visually similar to a low to medium degree and aurally similar to a less than medium degree. No concept is created by either mark. The contested mark is presented in a way that renders the ¡OJO! element subordinate to the CRÍA CUERVOS parts of the mark and it is CRÍA CUERVOS that dominates the mark and will be retained in the mind of the average consumer, to the extent that any uncommon word in a non-familiar language is retained in the mind. Neither CRÍA nor CUERVOS operate independently of each the other.

49. Given that neither the earlier mark nor the contested mark creates a concept in the mind of the consumer, there is no conceptual hook for the consumer to keep hold of. In such circumstances, a consumer may very easily imperfectly recollect CUERVO/CUERVOS. Though I find that even if the pluralisation of CUERVO in the later mark is noticed, this does not preclude the average consumer from concluding that the later mark is in some way related to the earlier CUERVO mark.

50. Justice Arnold (as he then was) gave helpful direction where there are some differences between the 'common' parts of conflicting marks in a case that concerned a conflict between the marks AVEDA and DABUR UVEDA.[10] In that case there was evidence of use of AVEDA, which coupled with the fact that AVEDA was an invented word with no concept, meant that it was highly distinctive for the relevant goods. He said:

> "48…As the hearing officer rightly accepted, UVEDA is both visually and aurally very close to AVEDA. The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear.

[10] [2013] EWHC 589 (Ch) Aveda Corporation v Dabur India Limited.

Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA…”

51. In this case the difference between CUERVO and CUERVOS is smaller, the latter simply being the plural of the former.

52. In short, a consumer familiar with CUERVO for alcoholic beverages would simply think that CRÍA CUERVOS used for an alcoholic beverage is a mark connected to the earlier CUERVO stable and I find there is a likelihood of confusion.

The opponent’s case under section 5(3)

53. I have given careful consideration to TC’s claim under section 5(3) of the Act. The reputation claimed by TC in respect of its CUERVO and JOSE CUERVO marks rests in its tequila and cocktails. Having looked at the evidence in detail it is clear that TC has a very strong reputation for at least tequila, in respect of the CUERVO and JOSE CUERVO marks. This is a far narrower range of goods than those I have already considered for the CUERVO ‘551 mark and, by TC’s own admission, the JOSE CUERVO mark is a further step away from the contested application.

54. Taking these factors into account, I see no benefit in determining what is, by the TC’s admission, its weaker case, when it has already succeeded in full on consideration of its ‘best case’ under the 5(2)(b) ground.

CONCLUSION

55. The opponent succeeds under sections 5(2)(b).

Costs

56. Tequila Cuervo, S.A de C.V. has been successful and is entitled to a contribution towards its costs. The cancellation was filed on 1 February 2023. Tribunal practice notice 1/2023 provides the applicable scale for tribunal cases launched on or after 1 February

2023 and is relevant here. I award costs on the following basis, bearing in mind that VCC did not attend the hearing:

Official Fee -	£200
Preparing a statement and considering the other side's statement -	£400
Filing evidence and considering the other side's evidence -	£800
Preparing for and attending a hearing -	£800
Total	**£2200**

57. I order Vinos Cría Cuervos S.L. to pay Tequila Cuervo, S.A de C.V. the sum of £2200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of July 2025

Al Skilton
For the Registrar,
the Comptroller General